

REMARKS

This Reply under 37 C.F.R. §1.111 is being submitted in response to the outstanding Office Action mailed April 6, 2006. In view of the following remarks, reconsideration and allowance of this application are respectfully requested.

In the Office Action, claims 1 – 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Carpenter et al. (EP 0717088). The Office Action states that Carpenter et al. “does not specifically name a binding agent. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to select compounds that would physically and chemically bind elements of the composition . . . .” (Office Action, page 2). This rejection is respectfully traversed for the following reasons.

M.P.E.P. §2143 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Claim 1, from which claims 2-38 depend, recites a coating agent for cellulose-bearing substrate surfaces wherein a bonding agent produces a bond between platelet-shaped pigments, a binding agent, and the cellulose-bearing substrate surface. However, Carpenter et al. does not disclose or suggest a coating agent wherein a bonding agent produces a bond between platelet-shaped pigments, a binding agent, and the cellulose-bearing substrate surface. Further, the Office Action does not provide any evidence that a reasonable expectation of success exists in the prior art for the incorporation of a bonding agent into the coating agent of Claim 1 in view of Carpenter et al. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” (M.P.E.P. §2143 citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Accordingly, claims 1 – 38 are not obvious in view of Carpenter et al. under 35 U.S.C. §103(a). Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

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In view of the foregoing remarks, this application is now in condition for Allowance. Reconsideration is respectfully requested. The Examiner is requested to telephone the undersigned if there are any remaining issues in this application to be resolved.

Finally, if there are any additional charges, the Examiner is authorized to charge applicants' Deposit Account No. 19-5425 therefore.

Respectfully submitted,

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